

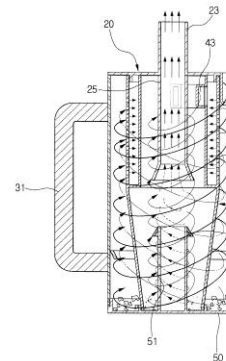
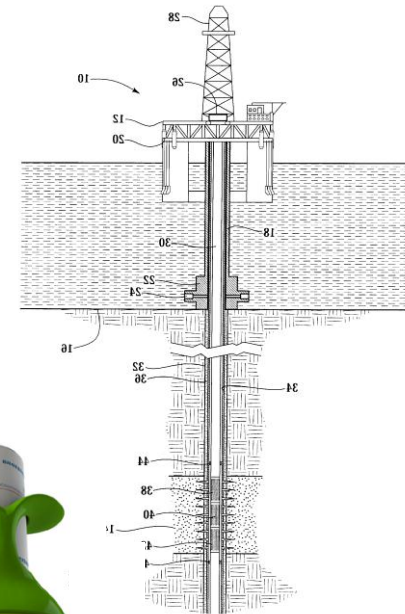
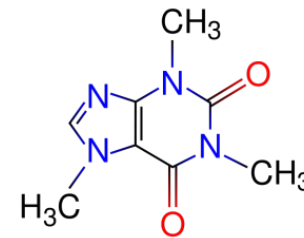
# Protecting Your Intellectual Property

Dr Richard Gibbs

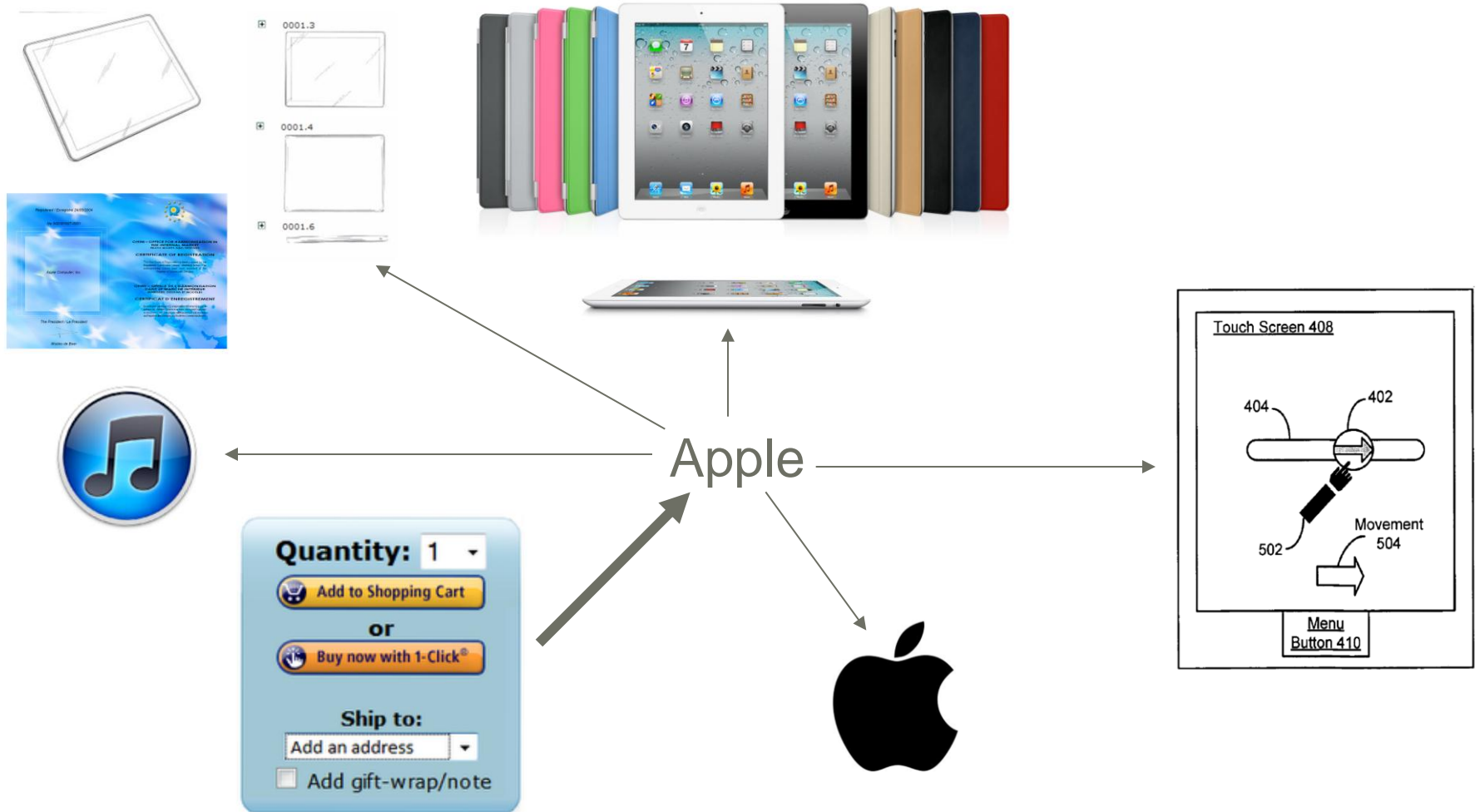
Marks & Clerk LLP

## What is IP?

- Patents
  - products, apparatus, manufacturing methods, processes
- Trade marks
  - company name, logo, product name
- Designs
  - Shape/ornamentation
- Copyright
  - software, drawings, operation manuals, website, marketing literature
- Know how and Confidential Information
  - new inventions, staff knowledge, manufacturing methods, products

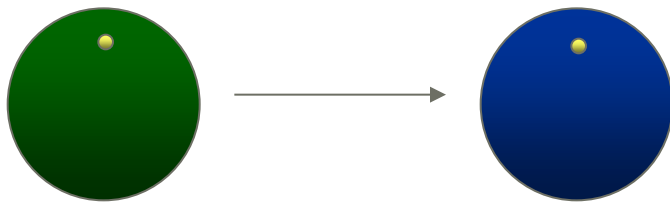


# How can it work for you?



## Identifying IP

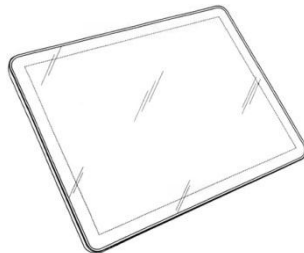
Patents – novel and inventive (industrially applicable/sufficiency)



Trade mark – distinctive; graphical representation?



Designs – novel with distinctive character



Copyright – what's left? The manifestation of an idea

Services



Mobile



Connected TV



News feeds



Alerts



E-mail news

About BBC News

Editors' blog  
BBC College of Journalism  
News sources  
Editorial Guidelines



Mobile site

Terms of Use  
Privacy  
Cookies

About the BBC  
Accessibility Help  
Contact the BBC  
Parental Guidance

## Identifying IP

- Capture
- Problems
  - Disclosures
  - Ownership
- Research
- Professional advice

## Identifying IP

- Communication – invention capture
- Staff meetings
- Invention disclosure procedures
  - Problem
  - Solution
  - The product
  - Prior art
  - Disclosures (past and future)
- Incentives
- “Dabble time”

## Securing your IP

- Avoid disclosures

UK Patent Act: 1977

2.-(1) An invention shall be taken to be new if it does not form part of the state of the art.

(2) The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way.

- Non disclosure agreement

<http://www.ipo.gov.uk/p-cda.htm>

- Limited effect
- Advice is always to avoid any disclosure

## Does the business own the IP rights?

- Communication
  - Regular and accurate notes/files
  - Dates of meetings
  - Minutes
  - Discussions with third parties (their contribution)
  - Signed NDAs
  - Invention disclosure forms
- Investors need to be confident that the business owns the IP rights
- Investors will want IP held in the name of the business, not individual
- Problem areas
  - Correct inventor identified?
  - Inventor's rights transferred to the business?
  - Former employers may have rights
  - Joint ownership?
  - Has an inventor recently left the business?
  - Existing agreements



## Research

- Is there a (or where is the) market for your idea?
- Where and what do you intend to sell?
- What is the state of the art?
- **Warning:** searching is a specialist subject

## Identifying IP

- Professional advisors
- Plan
- Write up
  - Invention disclosure forms
  - Background, materials methods, results, discussion
- Data
- Patentability opinion
  - assessment of prior art
  - comment on novelty and inventiveness
  - review of your data
  - recommendations
- Meeting

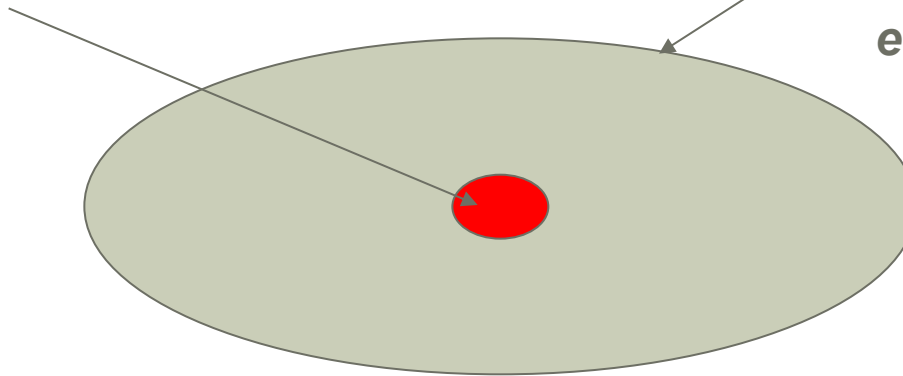
## What should you protect? Adding Value

- Does the patent protect the key product/process?
- Yes - primary focus  
Key product/process

*“A wooden chair with 4 legs”*

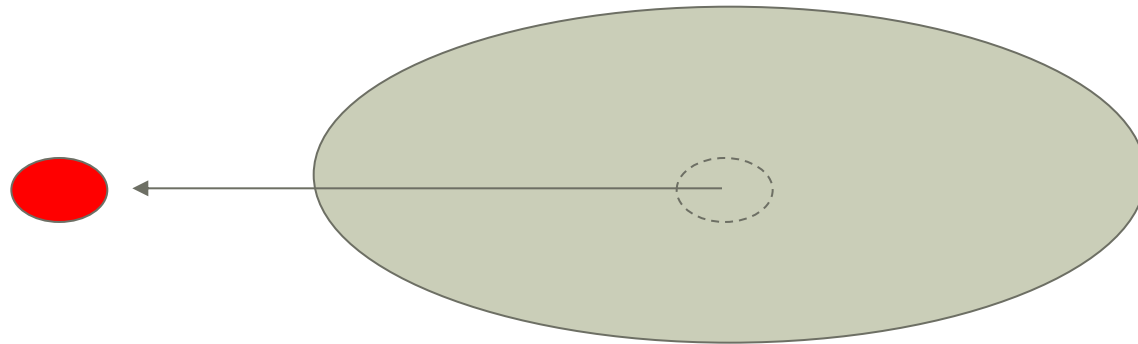
Claims

*“A support device with at least one ground engaging member”*



## Are key products covered?

- No

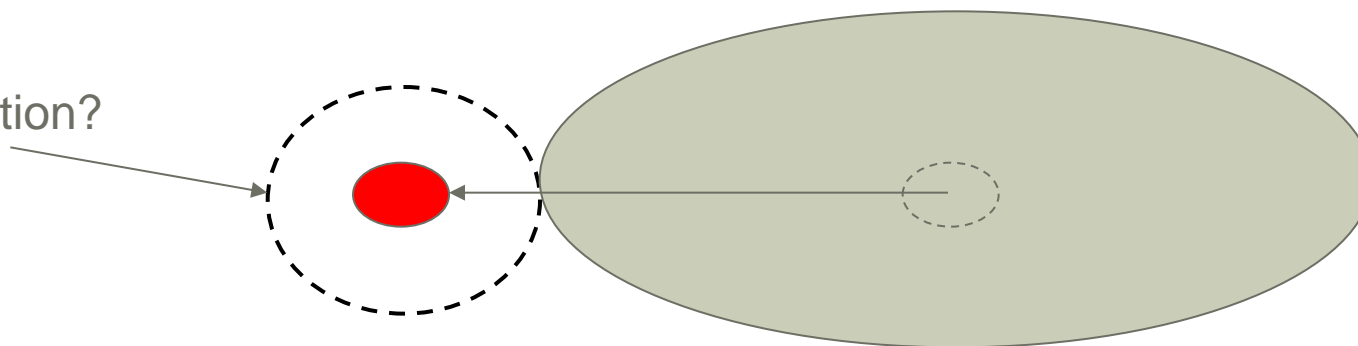


- Continuously monitor the connection between your IP and product to ensure this never happens
- Communication! (with staff & with advisers)

## Are key products covered?

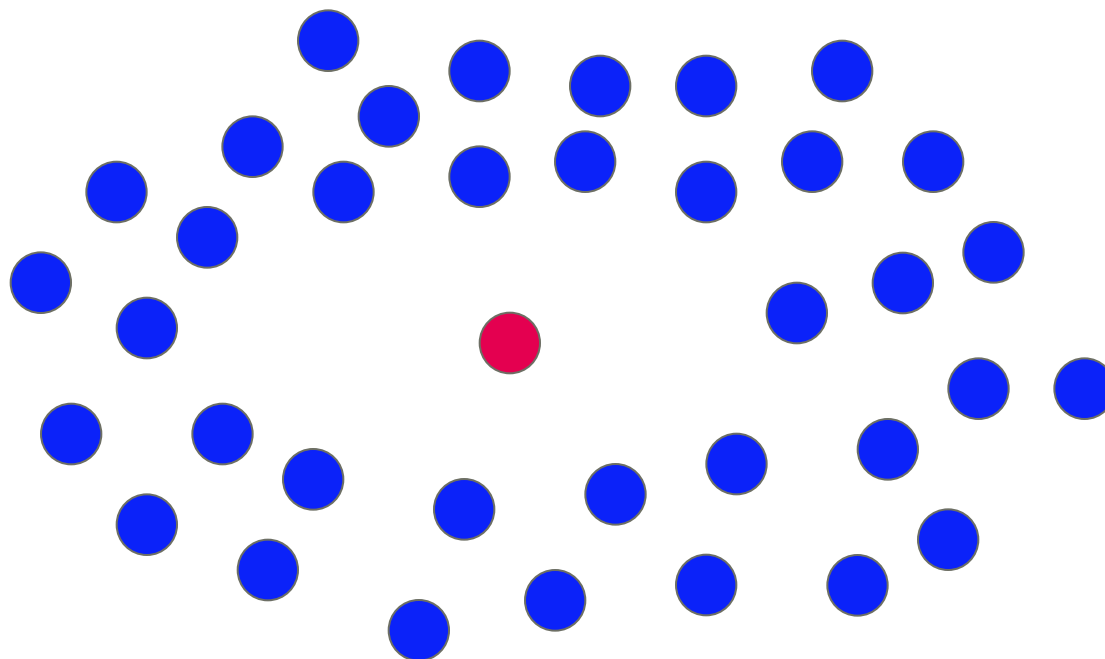
- Can this situation be fixed? Take advice on filing a new application

New application?



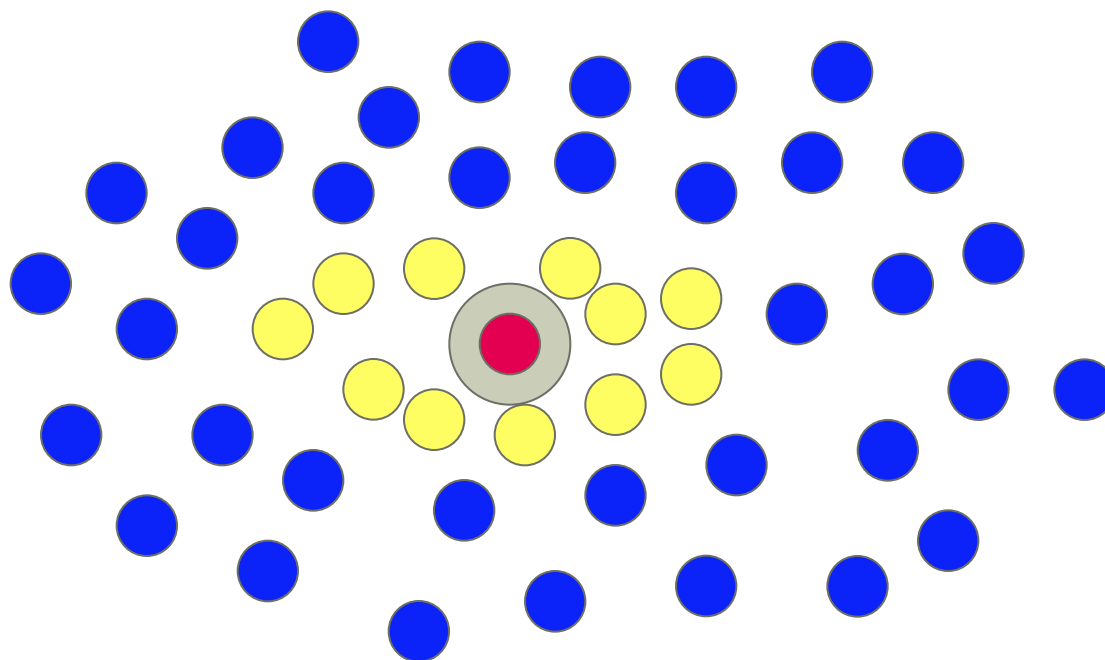
## What is the breadth of the IP rights?

- Your product is quite different from existing products (prior art)



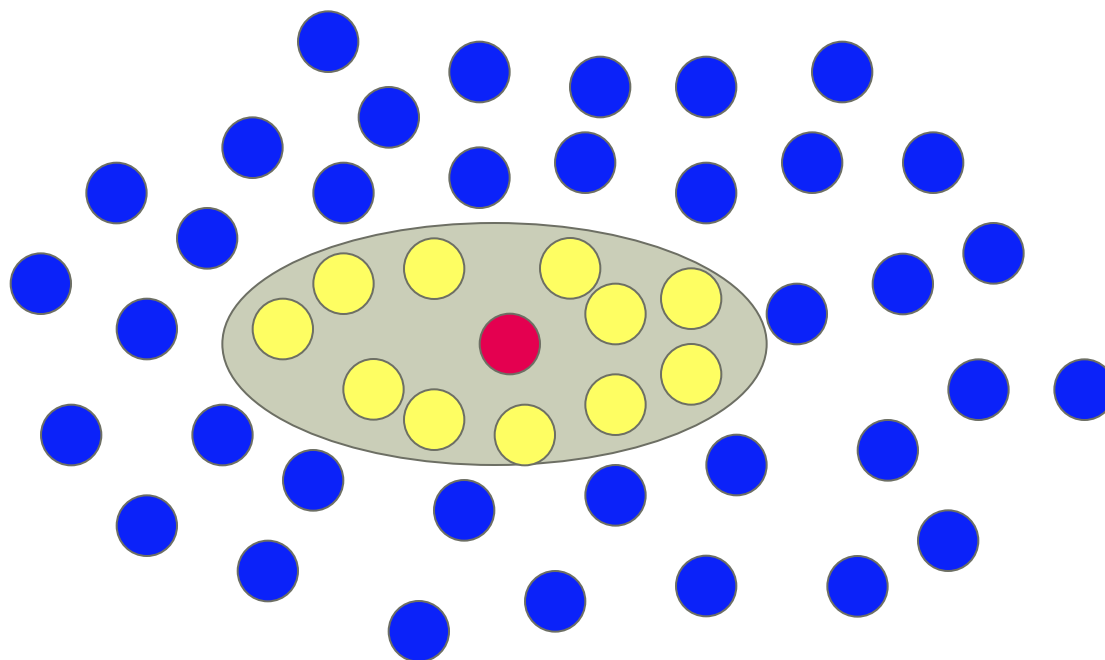
## What is the breadth of the IP rights?

- patent application covers the product – good but could be better



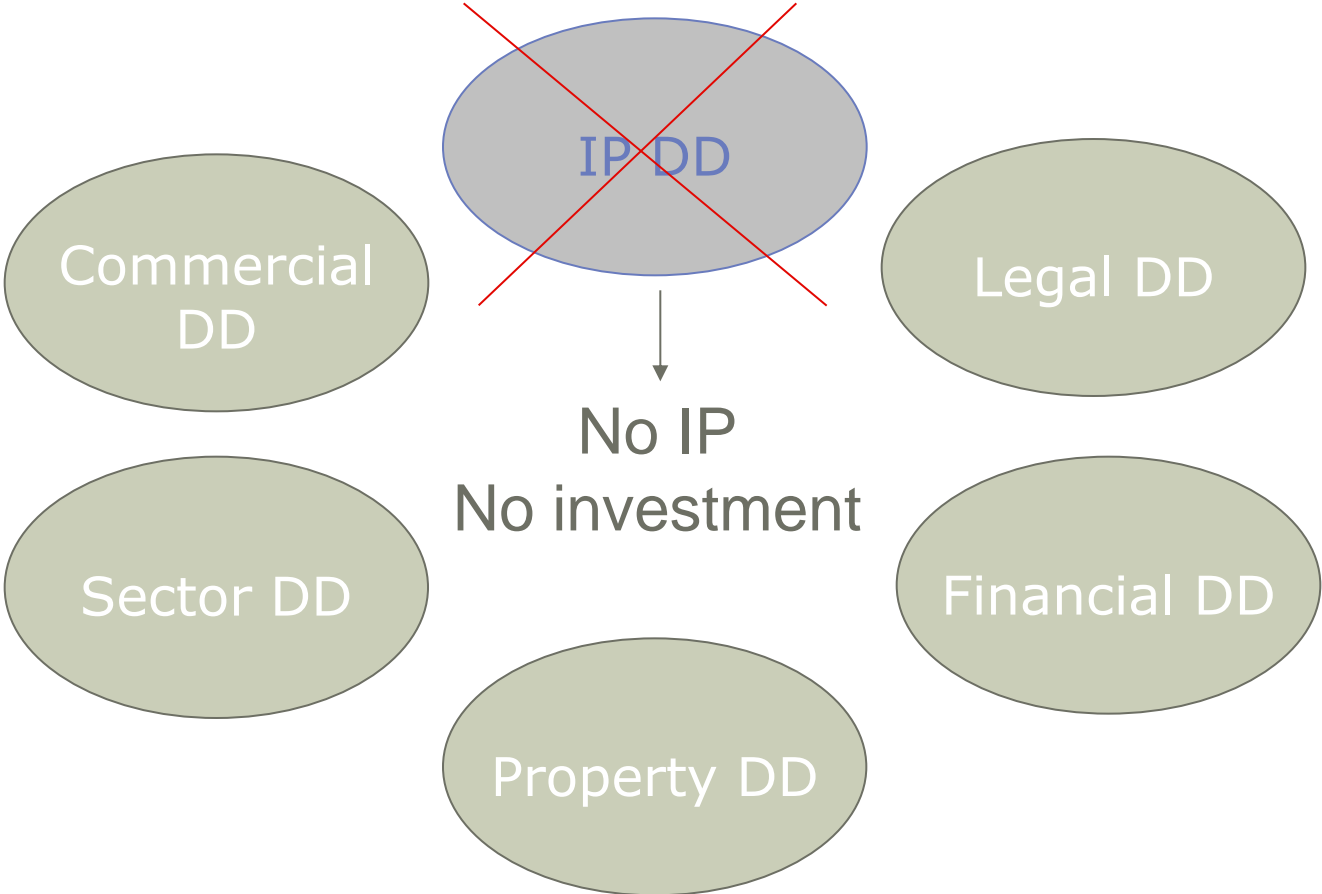
## What is the breadth of the IP rights?

- Scope should be as large as the prior art permits





**Is IP important to investors?**



## Is IP important to investors?

- Not just a count of patents
- Need to determine risk by the due diligence process
- Need to see how the “valuable” IP fits within business plan
- You need to demonstrate a clear IP strategy in business plan
- A good IP strategy should permit positive answers to DD questions
- ...and if not it should permit any risk to be identified early and managed

## What is the breadth of the IP rights?

- Have you filed for the right things, right jurisdictions, right time?
- Have the correct patent claims been made?
- New product claimed ... but also method of use, manufacture etc.
- First to invent an expansion cone:
  1. An apparatus comprising a cone to be driven through a tubular to effect expansion.
  2. A method comprising
    - a. running a tubular into a bore; and
    - b. expanding the tubular to define a larger diameter.

## What IP rights exist and what is the status?

- Stock-take of your IP - what IP exists, where it exists and at what stage
- Include all forms of IP
  - New inventions (not yet filed)
  - Unregistered trade marks
  - Copyright works
  - Confidential information
  - Know how

## What is the strength of the portfolio?

- Broad monopoly and no or limited weaknesses
- Investor may perform validity prior art searches
- Patent Office opinions relating to patent applications will be reviewed
  - Be ready to address any issues in advance and provide statements on likelihood of grant in light of any such opinions
- Independent prior art searches
  - Undertake such searches yourself to minimise surprises, and share results openly with investor
- If problem is identified, establish strategy for dealing with this

## Are there any threats from third parties?

- Is there Freedom to Operate?
- Investor will want to know about:
  - third party rights
  - infringement risk
- Independent searches
  - Undertake searches yourself early to minimise surprises
  - Consider the effect on your IP
  - Share results openly with you professional advisor/investor
- Identify and understand any problems early to determine solution
  - Design-around
  - Attack validity of third party, or at least arm yourself with evidence
  - Seek appropriate license

## Revenue opportunities

- Keep core IP which protects key products in key jurisdictions
- License or sell any of the IP?
- License out to permit others to sell your product in certain jurisdictions
- License or sell peripheral IP

# Protecting Your Intellectual Property

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